



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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GAU 3711
E. Chae
10-25-99
Reply
Brief
+ Oral
Hearing

Growth Art Unit: 3711
Examiner: William M. Pierce
Serial No. 09/017,959
Applicant: David A. Bernhardt
Filing Date: February 3, 1998
For: **BOWLING BALL
FINGER GRIP**

TRANSMITTAL OF
13
APPELLANT'S
REPLY BRIEF
IN RESPONSE TO
EXAMINER'S ANSWER

AND

REQUEST FOR
ORAL HEARING

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Enclosed herewith are the original and two copies of Appellant's Reply Brief and Request for Oral Hearing for the above-identified application.

A check in the amount of \$130.00 is enclosed to cover the fee due for requesting an oral hearing fee as required by 37 C.F.R. §1.17(g). If for some reason Appellant has inadvertently paid an insufficient fee to prevent the abandonment of this application, please charge our Deposit Account No. 08-0750 for any further fees which may be due. A duplicate copy of this transmittal is enclosed.

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Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

W.R. Duke Taylor
W. R. Duke Taylor
Reg. No. 31306
Attorneys for Applicant

Dated: October 11, 1999
P.O. Box 828
Bloomfield Hills, MI 48303
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BY:

Attorney Docket No. 8117-000021

WRDT/kmg

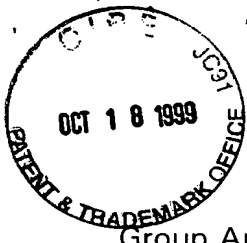
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on OCT 14 1999

By *W.R. Duke Taylor*

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Part #

13

Group Art Unit: 3711
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20231 on OCT 11, 1999

By W. R. COO

Dear Sir:

Applicant respectfully requests an Oral Hearing and includes the \$130.00 fee as specified under 37 C.F.R. §1.17(g).

REMARKS

This Reply Brief is in response to the Examiner's Answer mailed August 16, 1999.

In the Examiner's Answer, the Examiner indicates that Applicant has failed to state any authority as to why the issue, that the design patent has no specification, is important.

It is long settled that a rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference (cite omitted). Further, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. See *In re Spada*, 15 USPQ2d 1655, at 1657 (Fed. Cir. 1990).

First, Claim 1 requires the projections to have desired configurations such that when force is exerted by the bowler on the ball, the projections flatten providing a larger surface on the ball to enhance contact with the ball. This element is neither disclosed nor described in the Stevens reference. Further, with respect to the second prong of the test, the Stevens reference fails to describe Applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. That is, Stevens has no disclosure whatsoever indicating to one skilled in the art that the Stevens reference would meet the elements of Applicant's claims. Accordingly, the Stevens reference fails to disclose or suggest every feature and likewise fails to provide one skilled in the art with the wherewithal to conceptualize Applicant's invention from the Stevens disclosure.

Thus, Applicant believes that one skilled in the art would not consider the Stevens reference as disclosing all of the elements of Applicant's invention nor would it provide one skilled in the art with the teaching to procure it.

Applicant's invention provides the art with a bowling ball accessory or finger grip that is not anticipated by nor suggested nor disclosed by the prior art. Accordingly, reversal of the final rejection of Claims 1-16 and allowance of the claims is respectfully requested.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

Dated: October 11, 1999

BY:


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